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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91187644
Party	Plaintiff Mother's Nutritional Center, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MOTHER'S NUTRITIONAL CENTER,  
INC.,

Opposer,

v.

STORK STORE LLC,

Applicant.

Opposition No. 91/187,644

Appl. Serial No.: 77/452,966

Mark: STORK STORE and design

Published for Opposition: October 21, 2008

Atty. Ref. No.: 66309-0005

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**OPPOSITION TO MOTION TO DISMISS**

Opposer Mother's Nutritional Center, Inc. ("Opposer") hereby submits its Opposition to the Motion to Dismiss (the "Motion") filed by applicant Stork Store LLC ("Applicant").

**I. INTRODUCTION**

Applicant seeks dismissal of the Notice of Opposition filed by Opposer on the grounds that Opposer lacks standing and/or has failed to state a claim upon which relief can be granted. In order to survive Applicant's Motion to Dismiss, Opposer need only to allege facts that, if proven, show that it has standing and that there exists a statutory ground negating Applicant's entitlement to registration. Moreover, within the context of a motion to dismiss for failure to state a claim, all the well-pleaded allegations contained in the Notice of Opposition are deemed to be true. *Guessefeldt v. McGrath*, 342 U.S. 308, 311 (1952); *Kossick v. United Fruit Co.*, 365 U.S. 731, 732 (1961).

Here, Opposer has alleged: (1) that it owns trademark rights in its Stork Logo; (2) that its rights in its Stork Logo are senior to Applicant's rights in Applicant's mark; (3) that Applicant's

mark, when used in connection with Applicant's services, will create a likelihood of confusion with Opposer, Opposer's Stork Logo, and/or Opposer's services; and (4) that registration of Applicant's Mark will damage Opposer.

Opposer's allegations are clearly sufficient to establish both standing and to state a claim for relief. Accordingly, Applicant's Motion is wholly without merit and should be denied. If, however, the Board finds Applicant's Motion persuasive, Opposer respectfully requests that it be given leave to file an amended notice of opposition to cure any defects identified by the Board.

## **II. ARGUMENT**

A motion to dismiss is not a test of the merits of a claim, rather it tests only the legal sufficiency of a notice of opposition. To be legally sufficient, a notice of opposition must "set forth a short and plain statement showing why the opposer believes it would be damaged by the registration of the opposed mark and state the grounds for opposition." *See* 37 C.F.R. § 2.104(a). In other words, Opposer merely needs to allege facts that, if proven, would demonstrate (1) standing and (2) a statutory ground negating Applicant's entitlement to registration. *See, e.g., Young v. AGB Corp.*, 152 F.3d 1377, 1380 (Fed. Cir. 1998). Here, Opposer has fulfilled both requirements.

### **A. Standing**

To satisfy the standing requirement, an "opposer must have a 'real interest' in the proceedings and must have a 'reasonable' basis for his belief of damage." *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). *See also Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1101 (C.C.P.A. 1976); 15 U.S.C. § 1063 ("Any person who believes that he would be damaged by the registration of a mark upon the principal register . . . may . . . file an opposition in the Patent and Trademark Office, stating the grounds therefor.").

It is well settled that the standing requirement is satisfied where, as here, an opposer alleges a belief that a likelihood of confusion exists together with facts sufficient to show that its belief is reasonable. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (C.C.P.A. 1982) ("To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit . . .").

Here, without question, Opposer has alleged that it believes it will be damaged by the registration of Applicant's Mark. *See* Notice of Opposition, at 1. Opposer has also clearly alleged that it believes Applicant's Mark, when used in connection with Applicant's Services, will create a likelihood of confusion between Applicant, Applicant's Mark, and Applicant's Services, on the one hand, and Opposer, Opposer's Stork Logo, and Opposer's services on the other hand. *See* Notice of Opposition, ¶ 7.

The only remaining question is whether Opposer has alleged facts sufficient to show that its belief that a likelihood of confusion exists is reasonable. The answer to this question must be yes. Even Applicant admits that there are similarities between Applicant's Mark and Opposer's Stork Logo, *e.g.*, that "both marks have images of a stork carrying a baby in a blanket." *See* Applicant's Motion, at 3. Further, Applicant's services - retail stores featuring infant care products - are similar to Opposer's services - retail grocery stores - because infant care products are sold in grocery stores. *See* Notice of Opposition, ¶¶ 3, 6.<sup>1</sup>

Here, Opposer is not an "intermeddler" as Applicant suggests. Rather, Opposer has a genuine commercial interest in preventing the registration and use of marks, such as Applicant's Mark, that are confusingly similar to its Stork Logo. Opposer's belief that it will be damaged by

registration of Applicant's mark is reasonable and its allegations supporting likelihood of confusion are sufficient to establish standing. Accordingly, to the extent Applicant's Motion is made on the ground that Opposer lacks standing, Applicant's Motion must fail.

**B. Statutory Ground for Relief**

Opposer has identified Section 2(d) of the Lanham Act as the statutory basis for negating Applicant's entitlement to registration. *See* Notice of Opposition, ESTAA cover page. Pursuant to the statute, a mark is not entitled to registration if it "so resembles . . . a mark or trade name previously used in the United States by another . . ., as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." *See* 15 U.S.C. § 1052(d).

To satisfy the pleading requirements, Opposer need only allege facts showing:

(1) ownership and prior use of its Stork Logo; and (2) likelihood of confusion. *See id.* Opposer has alleged that it owns the Stork Logo. *See* Notice of Opposition, ¶ 5. Opposer has also alleged that has use the Stork Logo in connection with its retail grocery stores since prior to the filing date and alleged dates of first use claimed in Applicant's Application. *See id.* at ¶ 6. Opposer has also provided images comparing Applicant's and Opposer's marks, identified Applicant's and Opposer's services, and alleged that Applicant's mark so resembles Opposer's Stork Logo, that when Applicant's mark is used in connection with retail shops featuring infant care products is likely to cause confusion, or to cause mistake, or to deceive. *See id.* at ¶¶ 2-3, 5-7. For purposes of a motion to dismiss, all of these allegations must be deemed to be true. *See Guessefeldt v. McGrath*, 342 U.S. 308, 311 (1952); *Kossick v. United Fruit Co.*, 365 U.S. 731, 732 (1961).

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<sup>1</sup> In further substantiation of its belief that confusion is likely, Opposer also notes that, although not alleged in its Notice of Opposition, its retail grocery stores are a large, well-known chain, operated specifically and exclusively for new and expectant mother's and young children and in connection with a state nutrition program for the same.

Assuming them to be true, Opposer's allegations are sufficient to satisfy the relevant pleading requirements and, on that basis alone, applicant's Motion to Dismiss for Failure to State a Claim should be denied.

Opposer notes that whether the marks are confusingly similar, is a question of fact, not properly decided at the pleading stage. *See, e.g., Cardinal Engineering Corporation v. Champion Mfg. Co.*, 300 F.2d 957, 960-61 (C.C.P.A. 1962). Nonetheless, Applicant seeks to have this Opposition dismissed because, in its opinion, confusion is not likely. However, "a well-pleaded complaint may proceed even if it strikes a savvy judge that actual proof of those facts is improbable, and 'that a recovery is very remote and unlikely.'" *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 127 S. Ct. 1955, 1966 (2007).

In *Cardinal*, for example, the court reversed an order dismissing a notice of opposition where issue was likelihood of confusion between HYRDA-MATIC and WORKMASTER. *See Cardinal Engineering Corporation v. Champion Mfg. Co.*, 300 F.2d at 960-961. In *Cardinal*, the court reasoned:

The question of whether or not applicant's mark, when applied to its goods, so resembles opposer's previously used and registered mark as to be likely to cause confusion is a question of fact and not of law. Fact questions should ordinarily not be decided on a motion to dismiss. . . .

We, no more than the board, have any way of knowing the strength or weakness of the proofs appellant might have proffered in support of its allegations, but we do feel that the following excerpt from the Ethicon decision is relevant here:

opposer should not be deprived of an opportunity to present facts which it believes support its pleading and entitle it to the relief sought, irrespective of how insurmountable the task may seem at this juncture.

*Id.* Here, the marks at issue are much more similar than those in *Cardinal* - both feature storks carrying babies wrapped in blankets, the babies in the blankets are strikingly similar, and the services of each party are directed at new and expectant mothers.

Further, Applicant's arguments that confusion is not likely are based almost entirely on facts that are not properly before the Board, *e.g.*, the customers and clients of Applicant and Opposer, the location and geographical scope of services provided by Applicant and Opposer, and the services provided by Applicant and Opposer. *See* Motion, at 1. These arguments are improper as, "[g]enerally, a district court may not consider any material beyond the pleadings in ruling on a Rule 12(b)(6) motion" and none of the alleged "facts" cited in Applicant's arguments can be found in Opposer's pleading or the Applicant's application. *Hal Roach Studios, Inc. v. Richard Feiner and Co., Inc.*, 896 F.2d 1542, 1555 n.19 (9th Cir. 1990).<sup>2</sup>

Finally, even if the facts on which these arguments were properly before the Board, they are irrelevant to the extent that they reference limitations that do not appear in Applicant's application, such as customer base, channels of trade, goods and services, and geographical scope of services rendered. *See, e.g., Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 941 (Fed. Cir. 1990) (citing cases and stating "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.").

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<sup>2</sup> Applicant has not submitted any evidence to support the "facts" alleged in its Motion. Accordingly, Opposer requests that the Board will simply disregard these arguments for purposes of evaluating the motion. If, however, due to the inclusion of these alleged "facts", the Board chooses to treat Applicant's Motion as one for summary judgment, Opposer notes Applicant's Motion must fail because Applicant does not present any evidence in support of its position. Nonetheless, if the Board elects to treat the Motion as one for summary judgment, Opposer respectfully requests that it be given an opportunity to respond appropriately.

### **III. CONCLUSION**

For all the foregoing reasons, Applicant's Motion should be denied. If, however, the Board is inclined to grant Applicant's Motion, Opposer respectfully requests the opportunity to cure any defects identified by the Board by filing an amended Notice of Opposition.

Dated: January 12, 2009

By: /s/ JESSICA C. BROMALL

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## **CERTIFICATE OF SERVICE**

It is hereby certified that on **January 12, 2009**, a copy of the foregoing OPPOSITION TO MOTION TO DISMISS is being sent by first class mail, postage prepaid to the Applicant correspondence address of record:

Jonathan Zucker, Esq.  
27 N.Moore St.5th Floor  
New York, NY 10013

Date: January 12, 2008

Signed: \_\_\_\_\_  
Name: Michelle Boothby

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